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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KE, PENG

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/028,569	LAU ET AL	
	Examiner	Art Unit	
	Peng Ke	2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-14, 16-24 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14, 16-24, and 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to communications: Amendment, filed on 11/04/04.

This action is final.

Claims 1-4, 6-14, 16-24, and 26-34 are pending in this application. Claims 1, 11, 21, 31, and 33 are independent claims. In the Amendment, filed on 11/04/04, claims 1, 9, 11, 20, 21, 30, and 31 were amended, claims 33 and 34 were added, and claims 5, 15, and 25 were canceled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 4, 11 – 14, 21 – 24, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Cassorla et al., U.S. Patent No. 5,146,552.

As per claim 1, Cassorla teaches a method of augmenting multimedia content by a user comprising:

receiving a content selection from the user;

receiving an augmentation from the user; and

associating the augmentation with the content selection (see Cassorla, column 5, lines 8 – 24).

Exporting the augmentation and the content selection to an external application to launch the external application. (see Cassorla, column 7, lines 30 – 35).

As per claim 2, which is dependent on claim 1, Cassorla teaches the method of claim 1 (see rejection above). Cassorla further teaches the method of claim 1, wherein the augmentation is an annotation and further comprising storing the annotation (see Cassorla, column 5, lines 8 – 24).

As per claim 3, which is dependent on claim 2, Cassorla teaches the method of claim 2 (see rejection above). Cassorla further teaches the method of claim 2 further comprising:

displaying a list of annotations for the content selection to the user (see Cassorla, column 5, lines 26 – 30);

receiving an annotation selection from the user (see Cassorla, column 9, lines 23- 37);

receiving editing data from the user; and

editing the annotation selection according to the editing data (see Cassorla, column 5, lines 31 – 38 and column 9, lines 57 – 58).

As per claim 4, which is dependent on claim 2, Cassorla teaches the method of claim 2 (see rejection above). Cassorla further teaches the method of claim 2 further comprising:

storing the annotation and the content selection in a format suitable for use by an external application (see Cassorla, column 7, lines 36 – 41).

Claim 5 is cancelled.

As per claims 11 – 14 and 21 – 24, they are of similar scope to claims 1 – 4, respectively, and are rejected under the same rationale.

Claim 15 is cancelled.

Claim 25 is cancelled.

As per claim 31, Cassorla teaches a system for augmenting multimedia content by a user comprising:

- a presentation module to present a graphical interface to the user when the user selects content (see Cassorla, column 7, lines 41 – 43);

- an augmentation module to augment content selected by the user (see Cassorla, column 8, lines 11 – 13);

- an augmentation retrieval module to retrieve existing augmentations for the content selected by the user (see Cassorla, column 2, lines 25 – 30); and

- an augmentation export module to export an augmentation for the content selected by the user the user to launch an external application (see Cassorla, column 5, lines 21 – 24 and column 7, lines 30 – 35; column 7, lines 30 – 35).

As per claim 32, which is dependent on claim 31, Cassorla teaches the method of claim 31 (see rejection above). Cassorla further teaches the system of claim 31 further comprising:

- an augmented content database containing augmentations for the content selected by the user (see Cassorla, column 6, lines 51 – 67).

As per claim 33, it is rejected with the same rationale as claim 1. (Supra)

As per claim 34, which is dependent on claim 33, it is of the same scope as claim 4.

(Supra)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 9, 10, 16, 17, 19, 20, 26, 27, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla et al., U.S. Patent No. 5,146,552 in view of Borman et al., U.S. Patent No. 5,890,172.

As per claim 6, which is dependent on claim 1, Cassorla teaches the method of claim 1 (see rejection above). Cassorla further teaches the method of claim 1, wherein the augmentation is a bookmark (see Cassorla, column 2, lines 20 – 23).

Cassorla does not teach wherein the augmentation is a bookmark and further determining related sources with information related to the selected content; and associating the related sources with the bookmark. Borman teaches determining related sources with information related to the selected content; and associating the related sources with the bookmark (see Borman, column 3, lines 8 – 22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Borman with the method of Cassorla in order to save user time and effort in finding information.

As per claim 7, which is dependent on claim 6, Cassorla and Borman teach the method of claim 6 (see rejection above). Cassorla does not teach the method of claim 6 further comprising: displaying the related sources when the bookmark is accessed by the user; receiving a source selection from the user; and displaying information from the source selection to the user.

Borman teaches displaying the related sources when the bookmark is accessed by the user; receiving a source selection from the user; and displaying information from the source selection to the user (see Borman, column 3, lines 56 – 64). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Borman with the method of Cassorla in order to allow faster navigation of information by a user.

As per claim 9, which is dependent on claim 6, Cassorla and Borman teach the method of claim 6 (see rejection above). Cassorla further teaches the method of claim 6 further comprising: storing the bookmark, the related sources, and the content selection in a format suitable for use by an external application (see Cassorla, column 7, lines 36 – 41).

As per claim 10, which is dependent on claim 6, Cassorla and Borman teach the method of claim 6 (see rejection above). Cassorla further teaches the method of claim 6 further comprising:

exporting the related sources, along with the bookmark and the content selection to an external application (see Cassorla, column 7, lines 30 – 35).

As per claims 16, 17, 19 and 20 and 26, 27, 29 and 30, they are of similar scope to claims 6 – 10, respectively, and are rejected under the same rationale.

Claims 8, 18, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassorla et al., U.S. Patent No. 5,146,552 in view of Borman et al., U.S. Patent No. 5,890,172 as applied to claim 6 above, and further in view of Hansen et al., U.S. Patent No. 6,442,144.

As per claim 8, which is dependent on claim 6, Cassorla and Borman teach the method of claim 6 (see rejection above). Cassorla further teaches the method of claim 6, wherein determining related sources comprises:

examining a profile of the user (see Cassorla, column 7, lines 65 – column 8, line 16). Cassorla further teaches transmitting over a remote network connection using a network device (see Cassorla, column 7, lines 30 – 35).

Cassorla and Borman do not teach determining if a remote network connection is available; and determining if a local network device is available. Hansen teaches determining if a remote network connection is available; and determining if a local network device is available (see Hansen, column 2, lines 47 – 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Hansen with the method of Cassorla and Borman in order to allow a user to more readily discover available resources.

As per claims 18 and 28, they are of similar scope to claim 8 and are rejected under the same rationale.

Response to Argument

Applicant's arguments filed on 3/1/05 have been fully considered but they are not persuasive.

Applicant's argument focused on the following:

Applicant argues that Cassorla does not teach or suggest that exporting data from the electronic document application of the first user causes the electronic document application of the second user to launch.

Examiner disagrees. During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)

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In this case, the claim recites, "exporting the augmentation and the content selection to an external application to launch the external application." In Cassorla, a first user can transmit a file along with its augmentations to the workstation of a second user and that allows the second user to open the file and its augmentations with his applicant that is external to the workstation of the first user. (See Cassorla, col. 7, lines 25-54) Therefore, Cassorla meets the claim limitation because Cassorla teaches exporting the augmentation and the content selection to an external device, where a second user may open the file by launching an external application.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peng Ke whose telephone number is (571) 272-4062. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peng Ke

